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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/791,427

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Nael Naguib Zaki

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04/29/2009

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EXAMINER

DELCOTTO, GREGORY R

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

04/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/791,427

Applicant(s)

ZAKI ET AL.

Examiner

Gregory R. Del Cotto

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 and 105-110 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 and 105-110 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF-08)
Paper No(s)/Mail Date 9/08, 8/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-42 and 105-110 are pending. Claims 43-104 have been canceled.

Applicant's response filed 12/28/08 has been entered.

Objections/Rejections Withdrawn

The following objections/rejections as set forth in the Office action mailed 3/9/07 have been withdrawn:

The rejection of claims 16, 23, 106, and 107 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn.

Claim Rejections - 35 SC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-42, 105-107, and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heimann et al (US 6,281,189) in view of Carbonell (US 2003/0213747).

Heimann et al teach a composition containing at least one soybean oil derived compound and at least one member chosen from the group of drying agent(s), co-solvents, and additives. The composition can comprise methyl soyate, and d-limonene. See Abstract. More specifically, the composition contains from 0.5 to 20% by weight of at least one drying agent, about 1 to about 30% by weight of at least one cosolvent, additives from 0 to about 25% by weight, and 5 to 75% by weight of methyl soyate. See column 1, lines 45-69. Suitable additives include surfactants (e.g. anionic and nonionic), emulsifiers, antimicrobial compounds, etc. Suitable co-solvents include water, hydrocarbon glycols, and mixtures thereof among others. See column 2, lines 10-65. The compositions can replace toxic chlorinated solvents among other conventional and environmentally undesirable cleaners/solvents. Additionally, additives may be added to the compositions including dipropylene glycol n-butyl ether (butyl carbitol), etc. See column 2, lines 50-65. The inventive composition can be employed as a general purpose cleaner, parts cleaner, engine degreaser, tar and asphalt removal, printing press cleaner, metal cleaner, etc. See column 1, lines 30-45.

Heimann et al do not teach the use of a benzoic acid ester or a composition having the specific physical parameters containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Carbonell et al teach environmentally friendly solvents used to dissolve or remove residues and/or substances from substrates wherein the residue and/or substance is contacted with a generally recognized as safe solvent (GRAS) to dissolve the residue and/or substance in the solvent followed by the extraction of the residue and/or substance from the solvent such as by contact with carbon dioxide. See Abstract. These GRAS solvents are environmentally responsible solvents and include benzoic acid ester solvents such as methyl benzoic acid ester, isopropylbenzoic acid ester, methyl salicylate, ethyl salicylate, etc. See paras. 38-45. Preferably, the ester-containing solvent contains at least about 70-99% by weight of the one or more esters. See para. 50.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a benzoic acid ester solvent in the cleaning composition taught by Heimann et al, with a reasonable expectation of success, because Carbonell et al teach the use of solvents such as benzoic acid esters in similar cleaning compositions and that benzoic acid esters are environmentally friendly solvents and further, Heimann et al teach the use of various cosolvents which would encompass benzoic acid ester solvents.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Heimann et al in combination with Carbonell et al suggest a composition containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Note that, with respect to the pH, flash point, and other characteristics of the composition as recited by the instant claims (more specifically, instant claim 110), the Examiner asserts that the teachings of Heimann et al in combination with Carbonell et al would suggest compositions having the same pH, flash point, and other characteristics of the composition as recited by the instant claims because Heimann et al in combination with Carbonell et al suggest compositions containing the same components in the same proportions as recited by the instant claims.

Claims 1-19, 21-28, 33-42, 105, and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krawack (US 5,143,639) in view of Carbonell et al (US 2003/0213747).

Krawack teaches a compositions for removing inks and the like from printing machines. See column 1, lines 5-15. The compositions contain a mixture of 50 to 100% by weight of a C1-C5 alkyl ester of an aliphatic C8-C22 monocarboxylic acid or

mixture of such esters, 0 to 50% of vegetable oil, 0 to 10% of a surfactant, and a corrosion inhibitor in an amount up to 2% by weight. See column 2, lines 30-60. Suitable surfactants include Dehydol LT7 (heptaethylene glycol monolauryl ether, nonionic surfactant). See column 4, lines 35-50.

Krawack does not teach the use of a benzoic acid ester or a composition having the specific physical parameters containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Carbonell et al are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a benzoic acid ester in the cleaning composition taught by Krawack, with a reasonable expectation of success, because Carbonell et al teach the use of solvents such as benzoic acid esters in similar cleaning compositions and that benzoic acid esters are environmentally friendly solvents. Note that, it is prima facie obvious to combine two compositions, each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). See MPEP 2144.06.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims, with a reasonable

expectation of success and similar results with respect to other disclosed components, because the broad teachings of Krawack in combination with Carbonell et al suggest a composition containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Note that, with respect to the pH, flash point, and other characteristics of the composition as recited by the instant claims (more specifically claim 110), the Examiner asserts that the teachings of Krawack in combination with Carbonell et al would suggest compositions having the same pH, flash point, and other characteristics as recited by the instant claims because Krawack in combination with Carbonell et al suggest compositions containing the same components in the same proportions as recited by the instant claims.

Claims 20 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krawack (US 5,143,639) in view of Carbonell et al (US 2003/0213747) as applied to claims 1-19, 21-28, 33-42, 105, and 110 above, and further in view of Heimann et al (US 6,281,189).

Krawack and Carbonell et al are relied upon as set forth above. However, neither reference teaches the use of an odor-masking agent such as d-limonene in addition to the other requisite components of the composition as recited by the instant claims.

Heimann et al are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use d-limonene as a fragrance in the composition taught by Krawack, with a reasonable expectation of success, because Heimann et al teach use of d-limonene as an odorant in a similar cleaning composition and further, odorants such as d-limonene are notoriously well-known to those skilled in the art as suitable for use in cleaning compositions and desirable for such use.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19, 21-28, 33-43, and 105-110 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-17 of copending Application No. 11/248782 (has been allowed, but not issued) in

view of Carbonell et al (US 2003/0213747). Claims 1-17 of 11/248782 encompass all the material limitations of the instant claims except for the inclusion of an aromatic ester.

Carbonell et al are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a benzoic acid ester solvent in the cleaning composition claimed by '782, with a reasonable expectation of success, because Carbonell et al teach the use of solvents such as benzoic acid esters in similar cleaning compositions and that benzoic acid esters are environmentally friendly solvents and further, '782 claims the use of various cosolvents which would encompass benzoic acid ester solvents.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

With respect to the rejection using Heimann in view of Carbonell, Applicant once again states that this combination does not support a prima facie case of obviousness since the Patent Office provides no convincing line of argument that one of ordinary skill in the art would have been motivated to add a benzoic acid ester to the Heimann composition. Furthermore, Applicant states that even if one of ordinary skill in the art were to use such a benzoic acid ester in the composition taught by Heimann, Carbonell teaches at least 70% by weight of the benzoic acid ester which is outside the range of 10% to 60% by weight as recited by the instant claims. Additionally, Applicant states that the instant specification defines a cosolvent as any substance which upon addition to a composition increases the solubility of the composition in a particular substance,

such as water, and as such, one of ordinary skill in the art would understand that Heimann employs the term "co-solvent" in the same way that it is employed in the instant application. Thus, Applicant submits that the Patent Office's assertion that the benzoic acid ester of Carbonell would be a "co-solvent" within the meaning of Heimann is believed to be incorrect since Applicant contends that a benzoic acid ester would not increase the solubility of methyl soyate and d-limonene in water and therefore, would not function as a cosolvent.

At the outset, the Examiner maintains that it is well known to those skilled in the art that solvents used for removing paint, ink, graffiti, coatings, residues, etc., are interchangeable and those possessing environmentally friendly benefits are especially desirable. The Examiner maintains, as stated previously, that both Heimann and Carbonell et al are combinable as prior art since they are both drawn to the same field of endeavor, namely residue removal compositions. Carbonell et al is analogous prior art relative to Heimann and one of ordinary skill in the art clearly would look to the teachings of Carbonell to cure the deficiencies of Heimann et al. Additionally, the Examiner maintains, as stated previously, that Carbonell et al is a secondary reference relied upon for its teaching of benzoic acid ester as a solvent in a similar residue removal composition. The Examiner maintains that one of ordinary skill in the art would clearly have been motivated to use a benzoic acid ester solvent in the composition taught by Heimann, with a reasonable expectation of success, because Carbonell et al teach the use of solvents such as benzoic acid esters in similar cleaning compositions and that benzoic acid esters are environmentally friendly solvents and further, Heimann et al

teach the use of various cosolvents which would encompass benzoic acid ester solvents.

While Carbonell et al do teach that the compositions contain at least 70% by weight of the benzoic acid ester solvent, Heimann, which is the primary reference, teaches that cosolvents are used in the compositions in amounts from 1 to 30% by weight. The Examiner maintains, as stated previously, that one of ordinary skill in the art would be motivated to use the benzoic acid ester taught by Carbonell et al in the compositions of Heimann in amounts from 1 to 30% by weight which are the suitable amounts for cosolvent materials and not in the amounts used by the secondary reference. Said differently, Carbonell et al are relied upon for its teaching that benzoic acid esters are environmentally friendly solvents used in residue removing compositions and not for the amounts in which it is used in such compositions. Note that, the Examiner asserts that the cosolvents taught by Heimann are open to a wide variety of cosolvents and selection of a particular cosolvent is not critical to the composition taught by Heimann. Thus, the Examiner maintains that the teachings of Heimann in combination with Carbonell et al are sufficient to reject the instant claims under 35 USC 103. Further, the Examiner maintains that the definition of "cosolvent" as described in the instant specification is not necessarily applicable to the teachings of Heimann and that the cosolvent as described in Heimann will be given its broadest reasonable interpretation which would be an additional solvent enhancing the cleaning ability of the first solvent. As stated above, Carbonell et al teach that benzoic acid ester solvents are environmentally friendly solvents used to dissolve or remove residues and/or

substances from substrates which is the same field of endeavor and drawn to solving the same problem addressed by Heimann et al, namely cleaning and residue removal. Clearly, use of benzoic acid ester solvents in the composition taught by Heimann et al would enhance the cleaning ability of the composition and thus, would function as satisfactory cosolvent. Thus, the Examiner maintains that one of ordinary skill in the art would clearly be motivated to use the benzoic acid ester solvents as taught by Carbonell et al in the cleaning compositions taught by Heimann et al. Additionally, while Applicant states that Heimann suggests that a co-solvent is a co-solvent for the soybean oil derived compound and/or the drying agent and therefore, co-solvent has the same meaning as disclosed in the instant specification, the Examiner asserts that this disclosure of a co-solvent for the soybean oil derived compound taught by Heimann may be interpreted as an additional or extra solvent used in the composition.

With respect to the rejection of the instant claims under 35 USC 103 using Krawack in view of Carbonell, Applicant once again states that the Patent Office has employed impermissible hindsight in combining Krawack and Carbonell since one of ordinary skill in the art would not look to a reference that teaches compositions for removing fat and/or inks from printing equipment for components to add to a composition designed to remove petroleum residues from a substrate. Additionally, Applicant states that the Patent office has misinterpreted the holdings of *In re Kerkhoven*. . At the outset, as stated above, the Examiner maintains, as stated previously, that it is well known to those skilled in the art that solvents used for removing paint, ink, graffiti, coatings, residues, etc., are interchangeable and those possessing

environmentally friendly benefits are especially desirable. The Examiner maintains, as stated previously, that both Krawack and Carbonell et al are combinable as prior art since they are both drawn to the same field of endeavor, namely residue removal compositions. Additionally, the Examiner maintains that Carbonell et al is a secondary reference relied upon for its teaching of benzoic acid ester as a solvent in a similar residue removal composition. The Examiner maintains that one of ordinary skill in the art would clearly have been motivated to use a benzoic acid ester solvent in the composition taught by Krawack, with a reasonable expectation of success, because Carbonell et al teach the use of solvents such as benzoic acid esters in similar cleaning compositions and that benzoic acid esters are environmentally friendly solvents. Additionally, the Examiner maintains that the principle laid out in In re Kerkhoven has been properly applied by the Examiner. In short, both methyl soyate and benzoic acid ester are taught to be suitable as solvents used in residue removal compositions and where the prior art teaches two compositions useful for the same purpose (i.e., solvents for removing residue), it is obvious to combine these components to form a third composition for very same purpose. Furthermore, Carbonell et al teach that benzoic acid esters are environmentally friendly which makes the combination of solvents even more desirable. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With respect to the rejection of claims 20 and 29-32 under 35 USC 103 using Krawack in combination with Carbonell et al, and further in view of Heimann et al, Applicant states that Krawack in combination Carbonell et al is not sufficient to reject instant claim 1 and thus, Carbonell et al do not remedy the deficiencies of Krawack and Carbonell et al with respect to instant claim 1. In response, note that, the Examiner maintains that the teachings of Krawack in view of Carbonell et al are sufficient to suggest the claimed invention for the reasons set forth above. Heimann et al is a secondary reference relied upon for its teaching of d-limonene. The Examiner maintains that one of ordinary skill in the art clearly would have been motivated to use d-limonene as a fragrance in the composition taught by Krawack, with a reasonable expectation of success, because Heimann et al teach use of d-limonene as an odorant in a similar cleaning composition and further, odorants such as d-limonene are notoriously well-known to those skilled in the art as suitable for use in cleaning compositions and desirable for such use.

Additionally, Applicant states that even if the Patent Office has established a prima facie case of obviousness, a Declaration submitted under 37 CFR 1.132 and filed on 12/23/08 shows the unexpected and superior properties of the claimed invention in comparison to compositions falling outside the scope of the instant claims. Specifically, Applicant states that the presently claimed compositions are vastly superior to

compositions consisting of an aliphatic ester alone (e.g., methyl soyate) at dissolving asphalt. In response, note that, the Examiner asserts that the 132 Declaration is not sufficient to place the instant claims in condition for allowance. First, note that, there has been no comparison made to the closest prior art; Heimann and Krawack teach methyl soyate and various esters, respectively, while the Declaration provides data with respect to "biodiesel" which Applicant admits is a "proxy" for methyl soyate. Additionally, the data presented in the 132 Declaration is not commensurate in scope with the instant claims. For example, the instant claims recite broad amounts of any aromatic ester and broad amounts of any aliphatic ester while the Declaration provides data with respect to one specific embodiment containing 54% of isopropyl benzoic acid ester and 40% biodiesel which is not commensurate in scope with the instant claims. Thus, the Examiner asserts that the Declaration is not sufficient to show the unexpected and superior properties of the claimed invention in comparison to compositions falling outside the scope of the instant claims.

With respect to the double patenting rejection over 11/248,782 in view of Carbonell et al, Applicant states that the instant application has an earlier filing date than 11/248782 and that action on the instant rejection be deferred unless and until one or more of the allegedly conflicting claim of the copending application are placed into condition for allowance. In response, note that, a full and complete Office action includes all applicable rejections including provisional obviousness-type double patenting rejections. Furthermore, the provisional obviousness-type double patenting rejection will be maintained in an earlier filed application unless this is the only

outstanding rejection in which case it will then be withdrawn in the earlier filed application. Thus, since this is not the only rejection left in the case, the rejection has been maintained. See MPEP 804(I)(1). Furthermore, 11/248,782 has been allowed so once issued, it will no longer be a provisional-obviousness type double patenting rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory R. Del Cotto/
Primary Examiner, Art Unit 1796

/G. R. D./
April 27, 2009